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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,328	04/03/2001	Srinivas Gutta	US010164	1775

24737 7590 09/26/2006

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EXAMINER

NGUYEN, DUC M

ART UNIT PAPER NUMBER

2618

DATE MAILED: 09/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/825,328

Applicant(s)

GUTTA ET AL.

Examiner

Duc M. Nguyen

Art Unit

2618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,9-16,19-26,29-31 and 36-47 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 11, 15-16, 21, 25-26, 31, 38-39, 41, 45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

Continuation of Disposition of Claims: Claims withdrawn from consideration are 2-4,9,10,12-14,19,20,22-24,29,30,36,37,40,42-44,46 and 47.

DETAILED ACTION

This action is in response to applicant's response filed on 7/24/06. Claims 1-4, 9-16, 19-26, 29-31, 36-47 are now pending in the application. **This action is made final.**

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 11, 15-16, 21, 25-26, 31, 38-39, 41, 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said observed preferences" in line 5 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 9 recites the limitation "said observed preferences" in line 1 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 10 recites the limitation "said observed preferences" in line 1 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 11 recites the limitation "said obtained preferences" in line 7 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 19 recites the limitation "said observed preferences" in line 1 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 20 recites the limitation "said observed preferences" in line 1 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 2618

Claim 21 recites the limitation "said observed preferences" in line 8 of the claim.

There is insufficient antecedent basis for this limitation in the claim.

Claim 29 recites the limitation "said observed preferences" in line 1 of the claim.

There is insufficient antecedent basis for this limitation in the claim.

Claim 30 recites the limitation "said observed preferences" in line 1 of the claim.

There is insufficient antecedent basis for this limitation in the claim.

Claim 31 recites the limitation "said obtained preferences" in line 8 of the claim.

There is insufficient antecedent basis for this limitation in the claim.

Claim 38 recites the limitation "said observed preferences" in line 8 of the claim.

There is insufficient antecedent basis for this limitation in the claim.

Claim 39 recites the limitation "said observed preferences" in line 10 of the claim.

There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims **1, 11, 15-16, 21, 25-26, 31, 38-39, 41, 45** are rejected under 35

U.S.C. 103(a) as being unpatentable by **Ellis** (Provisional Application **60/270,463** for US

Pub. 2004/0116088) in view of **Asgharzadeh et al** (US Patent Number **5,590,246**).

Regarding claim 1, **Ellis** discloses a method for recommending an item (i.e, radio station) to a user, comprising the steps of:

- observing one or more environmental characteristics (see page 5, lines 17-28 regarding the user's current location determined by the GPS).
- determining preferences of said user **under** said one or more environmental characteristics (see page 5, line 17 to page 6, line 3 regarding the user's preferences or **profile** which is clearly used/determined "under" the current location to determine whether or not the preferred radio stations are available at (or under) this location via using a program schedule); and
- generating a recommendation score for said item based on features of said item and said observed preferences of said user under said one or more environmental characteristic include **at least one** of characteristic relating to a user location as claimed (see page 5, lines 17-28 regarding the user location as an index into a database of radio stations matching a user's criteria).

Here, although **Ellis** is silent on the recommendation score, it is noted that in order to recommend a radio station to a user, it is clear that the system in **Ellis** would obviously, if not implicitly, derive scores for recommended stations based on maximum scores in the similar way as mentioned by **Asgharzadeh** (see col. 2, lines 40-53). Therefore, the claimed limitation regarding a score is made obvious by **Ellis** and **Asgharzadeh**, for generating recommendation scores as claimed, in order to produce recommend radio stations to a user according their highest scores.

Regarding claims **11, 15**, the claims are rejected for the same reason as set forth in claim 1 above. In addition, since **Ellis** discloses the method is used for recommending a radio station based on the user's **current** location and program **schedule** (see page 5, lines 10-28), it is clear that the recommending radio station would obviously be based on a **given time** as claimed. Note that there is a correlation between a program schedule and a given time.

Regarding claims **21, 31, 38, 39**, the claims are rejected for the same reason as set forth in claim 11 above regarding a given time, wherein it is clear that a computer readable medium and/or a processor would be obviously, if not inherently, required in order to compute scores and generate a recommend radio station to a user.

Regarding claims **16, 25-26, 41, 45**, the claims are rejected for the same reason as set forth in claim 21 above. In addition, **Ellis** discloses said one or more environmental characteristic include **at least one** of characteristic relating to a user location as claimed (see page 5, lines 10 – 28 regarding the user "location" as an index into a database of radio stations matching a user's criteria).

Response to Arguments

5. Applicant's arguments filed 7/24/06 have been fully considered but they are not persuasive.

Regarding claim 1, Applicant contends that "The Office does not identify any single feature **Ellis** which corresponds to the claimed step of "determining preferences of said user under said one or more observed environmental

Art Unit: 2618

characteristics." The Office has not shown that at least one of the cited references teaches user preference determination **from** at least one of a weather condition, a characteristic of motion of said user, a location, and one or more characteristics of said location.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., user preference(s) is(are) determined **from** (or "**based on**") one or more observed environmental characteristics) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Accordingly, since **Ellis** discloses a method which is used for recommending a radio station based on the user's current location, user's preferences and program schedule (see page 5, line 10 – page 6, line 3), it is clear that the user's preferences (radio stations) are determined "under" the current location to determine whether or not the preferred radio stations are available at (or under) this location based on the program schedule, this would read on the limitation "determining preferences of said user under said one or more observed environmental characteristics".

In addition, just for the sake of arguments, let assume that the claim has been amended to recite the limitation "determining preferences of said user from (or based on) said one or more observed environmental characteristics", the examiner believes that the above limitation is still anticipated by Ellis. Here, since Ellis teaches

Art Unit: 2618

that the user's preferences (radio stations) are used to determine whether or not the preferred radio stations are available at this location based on the program schedule, Ellis would teach "determining preferences of said user from (or based on) said one or more observed environmental characteristics (location) via using the program schedule". Therefore, although the claimed invention using another approach such as learning the user's preferences at various environmental characteristics (i.e, locations) and then stored in a database for later use to determine/derive user's preferences at a particular or similar environmental characteristic, the claimed invention and Ellis are both directed to a method that determines preferences of said user based on said one or more observed environmental characteristics (location).

Note that while Ellis uses the program schedule database in order to determine the user's preferences at a particular location, the claimed invention using a learning data base to determine the user's preferences at a particular location. However, they **both** direct to a method that determines preferences of a user based on observed locations. Therefore, in order to overcome Ellis' reference, another feature and/or a distinct feature regarding the above data bases should be recited in the claim.

In response to applicant's argument that Asgharzadeh is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Asgharzadeh is used solely for its teaching in that when

Art Unit: 2618

recommending an item, a score for the item would be a necessary feature in order to recommend such item based on its computed score. Therefore, since Ellis discloses a method for recommending a radio station, Ellis would obviously, if not implicitly, compute a score for the radio station. Since Asgharzadeh and Ellis both teach a method that recommends an item, the combination is proper.

For foregoing reasons, the examiner believes that the pending claims which rely on the patentability of determining preferences of a user under one or more observed environmental characteristics are not allowable over the cited prior art.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. **Any response to this final action should be mailed to:**

Art Unit: 2618

Box A.F.

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(571) 273-8300 (for formal communications intended for entry)

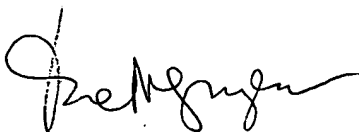
(571)-273-7893 (for informal or draft communications).

Hand-delivered responses should be brought to Customer Service Window,
Randolph Building, 401 Dulany Street, Alexandria, VA 22314.

Any inquiry concerning this communication or communications from the examiner
should be directed to Duc M. Nguyen whose telephone number is (571) 272-7893,
Monday-Thursday (9:00 AM - 5:00 PM).

Or to Matthew Anderson (Supervisor) whose telephone number is (571) 272-
4177.

Duc M. Nguyen



Sept 20, 2006